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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 09/972,930 | 10/10/2001 | Yuki Akiyama | TESJ.0040 | 4840 |
| 38327 | 7590 | 02/24/2005 | EXAMINER | |
| REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042 | | | TAYLOR, APRIL ALICIA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2876 | |

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

CT

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|------------------------------|-----------------|---------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/972,930 | AKIYAMA, YUKI | |
| | Examiner | Art Unit | |
| | April A. Taylor | 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-15 and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 29 November 2004.

Remarks

2. The indicated allowability of claims 11, 12, 19, and 20 from previous Office Action (mailed on 7/29/04) is withdrawn in view of recognition that Ike et al as modified by Matsumoto et al teaches the subject matter of claims 11, 12, 19, and 20. The delay in citation of the above art is regretted. Rejections based on the above identified prior arts follow. **Therefore, this action is not made Final.**

Claim Objections

3. Claim 15 is objected to because of the following informalities: Claim 15 is dependent upon claim 2, which has been cancelled. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Claim 15 recites the limitation "the bar code" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 3-10, 13, 14, 17, 18, 21, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Ike et al (US 2002/0169714), hereinafter Ike.

Re claims 1, 8, 9, 10, and 17: Ike teaches a system for reading display information comprising:

an information display member 50, wherein the information display member is a paper ad;

at least one mobile communication terminal 30 of a public mobile communication system for reading at least a portion of the display information displayed on the information display member 50;

wherein the information display member 50 comprises an information recording element 60 in which necessary and/or optional information of the information portion is stored, the mobile communication system comprises a reader mechanism 30 for

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reading information recorded in the information recording element 60 and a display mechanism for displaying the read information, and the information recorded in the information recording element 60 including the portion of the display information displayed on the information display member 50;

wherein the information recording element 60 includes an RFID chip, which serves as an IC chip as recited in claim 1, having an antenna for communicating with the mobile communication terminal;

means for displaying in an enlarged manner a desired portion of the information displayed on the display mechanism of the mobile communication system; and

wherein the information display member 50 includes a signal member carrying a signal displayed by characters for notifying an existence of the information recording element 60, and wherein the mobile communication system further comprises means for detecting the signal member. (See figure 3; and page 2, paragraph 28 to page 4, paragraph 40)

Re claim 3: Ike teaches wherein the information recorded in the reader mechanism 30 is transferred to a system having a function of a communication terminal (see page 2, paragraph 28 to page 3, paragraph 39).

Re claim 4: Ike teaches wherein the information recorded in the reader mechanism 30 is transferred via a net line of a LAN (see page 3, paragraph 38).

Re claim 5: Ike teaches wherein the information recorded in the reader mechanism 30 is further recorded in a server system (see page 2, paragraph 28 to page, 3 paragraph 39).

Re claim 6: Ike teaches wherein text information is stored in the information recording element 60 (see page 2, paragraph 28).

Re claim 7: Ike teaches wherein the information recorded in the reader mechanism 30 is copied (see page 2, paragraph 28).

Re claim 13: Ike teaches wherein the mobile communication system includes a mobile phone (see figure 1; page 2, paragraph 28).

Re claim 14: Ike teaches wherein the reader mechanism reads information from the information recording element in a non-contact manner (see page 3, paragraph 39 to page 4, paragraph 40).

Re claim 18: Ike teaches wherein the mobile communication system further comprises reading-out means for reading the text information into voice (see page 3, paragraph 32).

Re claims 21 and 22: Ike teaches wherein the means for detecting the signal member includes a satellite transponder which electrically communicates with the signal member (see page 2, paragraph 28 to page 3, paragraph 39).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 11, 12, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ike et al (US 2002/0169714 A1) in view of Matsumoto et al (US 2002/0139861).

Ike teaches a system for reading display information comprising an information display member 50 including an information recording element 60; and a mobile communication system 30 including a reader mechanism and a display portion.

Ike et al fails to teach or fairly suggest wherein the information recording element has a function of counting the number of times that the information is read and storing the number of counts in a recording medium.

Matsumoto et al teaches an IC card information display device comprising an IC card for storing a plurality of kinds of application information and maintaining a display count information representing a number of times each of the plurality of kinds of application information is read (see page 9, paragraph 95; page 11, claim 15; and page 12, claim 20).

In view of Matsumoto et al's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a counting function to the teachings of Ike et al in order to keep track of how often consumers view the paper ad.

Response to Arguments

11. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to April A. Taylor whose telephone number is (571) 272-2403. The examiner can normally be reached on Monday - Friday from 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [april.taylor@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


AAT

21 February 2005

DANIEL STCYR
PRIMARY EXAMINER

